

REMARKS

Claims 1 and 3-10 are pending in this application. By the Office Action, claims 9-10 are withdrawn from consideration; claims 1 and 5-8 are rejected under 35 U.S.C. §102(e); claims 2-4 are rejected under 35 U.S.C. §103(a); and claims 1 and 5-8 are rejected for obviousness-type double patenting. By this Amendment, claims 1, 3, and 4 are amended, and claim 2 is canceled. No new matter is added.

I. Unity of Invention

Claims 9-10 are withdrawn from consideration in response to a Lack of Unity of Invention Requirement. Applicants respectfully traverse the Requirement.

In the Office Action, it is asserted that the Requirement is proper at least because the invention of claim 1 was found in the art, and because only Group II (claims 9-10) included the blackened layer of Cu-Co alloy particles. However, for all of the reasons set forth below, claim 1 is patentable over the art, and has been amended to specify that the blackened layer is formed of Cu-Co alloy particles. Accordingly, for at least these reasons, and the reasons previously set forth, the Requirement is improper and should be withdrawn.

II. Rejection Under §102(e)

Claims 1 and 5-8 are rejected under 35 U.S.C. §102(e) as being anticipated by Kojima. Although Applicant does not necessarily agree with the rejection, in the interest of advancing prosecution claim 1 is amended to incorporate the subject matter of non-rejected claim 2. Accordingly, the rejection is overcome and must be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections Under §102(e)

Claims 2-4 are rejected under 35 U.S.C. §103(a) over Kojima in view of Hong.
Claims 2 and 4 are rejected under 35 U.S.C. §103(a) over Kojima in view of Nippon Mining

Co. Claim 3 is rejected under 35 U.S.C. §103(a) over Kojima in view of Nippon Mining Co. and further in view of Kadokura. Applicant respectfully traverses these rejections.

As indicated in the Office Action, the primary reference Kojima is available as prima facie prior art to the present application only under 35 U.S.C. §102(e). Kojima is assigned on its face to Dai Nippon Printing Co., Ltd., as is the present application. The assignment for Kojima is recorded in the U.S. Patent and Trademark Office at Reel 013326, Frame 0658; the assignment for the present application is likewise recorded in the U.S. Patent and Trademark Office at Reel 016302, Frame 0595. Furthermore, the present application and Kojima were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Dai Nippon Printing Co., Ltd.

However, under the provisions of 35 U.S.C. §103(c), commonly assigned applications that are available as prior art only under 35 U.S.C. §102(e), (f) or (g) are no longer applicable as prior art to the claimed invention in an obviousness rejection. Because amended §103(c) applies to Kojima, Kojima is not available as a prior art reference to the claimed invention in the §103 rejection.

Accordingly, Kojima is disqualified from being used as a reference under 35 U.S.C. 103(a), and the rejections must be withdrawn. Because the remaining references cannot support the rejections, the rejections are overcome and must be withdrawn. Reconsideration and withdrawal of the rejections are respectfully requested.

IV. Rejection For Obviousness-Type Double Patenting

Claims 1 and 5-8 are rejected for obviousness-type double patenting over copending applications numbers 10/297,830, 10/370,098, 10/521,997, 10/519,454, 10/562,424, and 10/550,948, and over U.S. Patent No. 7,037,594. Although Applicant does not necessarily agree with the rejections, in the interest of advancing prosecution claim 1 is amended to incorporate the subject matter of non-rejected claim 2. Accordingly, the rejections are

overcome and must be withdrawn. Reconsideration and withdrawal of the rejections are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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JAO:JSA

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